

REMARKS

Status of the Claims

Upon entry of the amendment above, claims 1-5 and 7-30 will be pending, claims 1 and 26 being independent.

Summary of the Office Action

Claim 5 is rejected under 35 USC §112, second paragraph, as being indefinite.

Claims 1 and 3-8 are rejected under 35 USC §102(b) as being anticipated by SHIN et al. (U.S. Patent No. 5,975,861, hereinafter "SHIN").

Claims 1 and 3-8 are rejected under 35 USC §102(b) as being anticipated by CHANG (U.S. Patent No. 4,918,838).

Claims 1 and 3-9 are rejected under 35 USC §102(b) as being anticipated by PREMAN et al. (U.S. Patent No. 5,224,280, hereinafter "PREMAN").

Claim 2 is rejected under 35 USC §103(a) as being unpatentable over PREMAN.

Response to the Office Action

A. Summary of Amendment

The claims, specification, and drawings have been added, as mentioned below. No prohibited new matter has been added.

1. Claims

Independent claim 1 has been amended to include therein the subject matter of former claim 6 (which has been canceled), that is, a layer of shock-absorbing material (such as identified by reference numeral 140 or 240 in the exemplary drawings) is specified as being positioned between the elastically deformable element (see, e.g., element 130 in the drawings) and the outsole (see, e.g., element 150).

In addition, independent claim 1 has been amended to specify that the elastically deformable element extends from an "uppermost portion" downwardly to medial and lateral edges of the outsole.

In addition, new claims 10-30 have been added, of which claim 26 is independent.

2. Specification

Paragraphs 0005, 0034, 0035, and 0067 have been amended for cosmetic reasons which are believed to be self-explanatory.

Paragraph 0030 has been amended to introduce the expression “uppermost portion,” with reference to the elastically deformable element.

In addition, a sentence has been added to the end of paragraph 0030 to describe that which is clearly shown in the drawings, as originally filed. As can be seen in the cross-sectional views of Figs. 5 and 6 and others, the elastically deformable element 130 extends transversely at least to locations vertically beneath the medial and lateral sides of the upper 110.

3. Drawings

Although the drawings were not objected to in the Office action, Applicants have attached hereto two “Replacement Sheets,” i.e., sheet 1/10 and sheet 2/10, the former including Figs. 1 and 2 and the latter including Figs. 3 and 4. The amendment consists of the expression “Prior Art” having been added in each of Figs. 1-4, consistent with the brief description of the drawings on page 5 of the specification and the background section of the specification.

B. Withdrawal of Rejection Under 35 USC §112, Second Paragraph

In the amendment above, dependent claim 5 has been amended by deleting the word “on,” to improve the meaning of the claim.

In view of the amendment, reconsideration and withdrawal of the rejection of claim 5 under 35 USC §112, second paragraph, is requested.

C. Withdrawal of Rejection Under 35 USC §102(b) Based Upon SHIN

At least for reasons given below, reconsideration and withdrawal of the rejection of 1 and 3-8 under 35 USC §102(b), based upon SHIN, is requested.

Initially, Applicants note that dependent claims 3 and 4 are serially dependent from claim 2 and that claim 2 has not been rejected on SHIN, either under §102(b) or otherwise; therefore, Applicants submit that the rejection of claims 3 and 4 should be withdrawn at least for this reason.

Regarding the other claims that stand rejected over SHIN, Applicants respectfully submit that SHIN fails to teach or suggest the invention and, therefore, the rejection

should be withdrawn.

First, the “elastically deformable element 11” of SHIN, identified in the rejection as corresponding to Applicants’ elastically deformable element, is **not** substantially arch-shaped in transverse cross section, as Applicants claim.

In this regard, if a transverse cross section were to be taken of the pumping assembly 10 (of which element 11 is a part) in SHIN’s Fig. 1, the assembly would be **rectangular, with a straight top edge** – not arch-shaped. Fig. 3, which shows a curved top, is a *longitudinal* section (elements 16 and 17 being *front and rear* check valves).

Second, even if the top of SHIN’s assembly 10 were arched in transverse cross section, there is no disclosure/illustration of the deformable element 11 extending downward to the medial and lateral edges of the outsole. In fact, Fig. 1 shows that the total width of the assembly 10 is much less than the width of the outsole.

D. Withdrawal of Rejection Under 35 USC §102(b) Based Upon CHANG

At least for reason given below, reconsideration and withdrawal of the rejection of 1 and 3-8 under 35 USC §102(b), based upon CHANG, is requested.

Fig. 1 shows the element 22 of CHANG, which is identified in the rejection as corresponding to Applicants’ elastically deformable element, to be about the same width as SHIN’s element. Accordingly, is the element 22 not wide enough to extend from a medial edge to a lateral edge of the outsole, as specified in Applicants’ claim 1.

E. Withdrawal of Rejection Under 35 USC §102(b) Based Upon PERMAN

At least for reasons given below, reconsideration and withdrawal of the rejection under 35 USC §102(b), based upon PERMAN, is requested.

The rejection relies upon the embodiment of Figs. 3-5 of PERMAN and identifies element 3 as the elastically deformable element of the rejected claims.

As mentioned above, Applicants’ claim 1 calls for the elastically deformable element (such as element 130 in Applicants’ drawings) to have an arch shape extending from an uppermost portion downward to medial and lateral edges of the outsole.

In contrast, at the medial and lateral edges of the outsole, PREMAN's transverse member 3 extends vertically upwardly in vertical portions 14. See column 5, lines 43-46.

Further, the ***uppermost portion*** of PREMAN's member 3 is either of the vertical portions 14. Neither of the vertical portions 14 can be said to correspond to Applicants' uppermost portion from which Applicants' arch shape extends transversely and downwardly to medial and lateral edges of the outsole.

In the disclosure of PREMAN the vertical portions 14 of the member 3 and channels 15 are important. Further, with the vertical portions 14 of PREMAN extending quite high, as shown in Fig. 3, it would appear that the PREMAN bottom assembly could not possibly function in the manner shown in Applicants' Fig. 6, whereby the intermediate member 160 on the upslope side of the shoe 100 is quite compressed. In PREMAN, vertical portions 14 would appear to provide vertical rigidity, perhaps similar to the example of the prior art shown in Applicants' Fig. 2 and explained in paragraph 0012 of your specification (and paragraphs 0007, 0008).

Further, in contrast to Applicants' claim 3, Applicants' note the mention in the rejection that zone 22 of PREMAN's element 3 is "substantially planar" (line 8 of Section 6 of the rejection). Applicants respectfully disagree. Zone 22 of PREMAN's element 3 is not planar, nor is it substantially planar.

F. Withdrawal of Rejection Under 35 USC §103(a) Based Upon PERMAN

At least for reasons given above in connection with claim 1, reconsideration and withdrawal of the rejection of claim 2 under 35 USC §103(a), based upon PERMAN, is requested.

G. New Claims 10-30

In the amendment above, new dependent claims 10-30 have been added.

New claims 10 and 11 depend from claim 1 and add that the elastically deformable element comprises polyurethane and polyethylene, respectively.

New claim 12 specifies that the elastically deformable element comprises a composite material having a Young's modulus of at least 50 Mpa.

New claim 13 depends from claim 1 and is additionally directed to the shape of the elastically deformable element, specifically stating that it "does not extend upwardly at the medial and lateral edges of the outsole," which contrasts with the vertical portions 14 of PERMAN.

New claims 14 and 15 depend from claim 1 and add, respectively, that the elastically deformable element is located in the heel zone (claim 14) of the article of footwear and in the forefoot zone (claim 15) of the article of footwear.

New claim 16 specifies that the elastically deformable element is located in **both** the heel zone and in the forefoot zone of the article of footwear.

New claim 17 depends from claim 16 and specifies that "in the forefoot zone of the article of footwear, the elastically deformable element has a height greater than a height of the elastically deformable element in the heel zone of the article of footwear. "

By contrast, new claim 18, which also depends from claim 16, specifies that "in the forefoot zone of the article of footwear, the elastically deformable element has a height less than a height of the elastically deformable element in the heel zone of the article of footwear. "

New claim 19 also depends from claim 16 and further adds a limitation of "a sole reinforcement element" (such as element 180 in Applicants' drawings), and that the elastically deformable element comprises a rear part of the sole reinforcement element and a front part of the sole reinforcement element, the front part of the sole reinforcement element being planar.

New claim 20 depends from claim 19 and adds that the front part of the sole reinforcement element is connected to the rear part of the sole reinforcement by means of a inclined zone in a plantar arch area.

Each of new claims 21-24 depends from claim 8 and adds that the connecting member/wedge of claim 8 comprises one of different materials, respectively, that is EVA, TPU, PU, and PA.

New claim 25 further specifies that the arch shape of said elastically deformable element extends transversely from the uppermost central portion at least to a position vertically beneath a medial side of the upper and at least to a position vertically beneath a lateral side of the upper. In none of the documents relied upon in the rejections under 35 USC §102 and §103, is there an arch shaped element that extends as far as specified in claim 25.

Like claim 1, new independent claim 26 is directed to an article of footwear. More specifically, claim 26 calls for an outer bottom assembly positioned beneath the upper and including, inter alia, an elastically deformable element having a substantially arch-shape in a transverse direction, with the elastically deformable element extending transversely and downward from an uppermost central portion at least to a position vertically beneath the medial side of the upper and at least to a position vertically beneath the lateral side of the upper. As mentioned above in connection with claim 25, none of SHIN, CHANG, and PREMAN teach or suggest such limitation.

New claim 27, which depends from claim 26, specifies that the shock-absorbing material positioned between the elastically deformable element and the outsole comprises a foam having a hardness between 20 and 200 Asker C.

New claim 28, also depending from claim 26, specifies that the material of the intermediate member of claim 26 comprises a foam having a hardness between 20 and 200 Asker C.

New claim 29, which depends from claim 26, specifies that the elastically deformable element extends transversely from a medial edge to a lateral edge and that the elastically deformable element has an upwardly facing convex surface between the medial and lateral edges.

New claim 30 depends from claim 29 and further adds a limitation relating to the elastically deformable element comprising a plurality of arms projecting outwardly from the medial edge and a plurality of arms projecting outwardly from the lateral edge.

SUMMARY AND CONCLUSION

The grounds of rejection advanced in the Office action have been addressed and are believed to be overcome. Reconsideration and allowance are respectfully requested in view of the amendment and remarks above.

A check is attached for payment of a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized to charge any fee required for acceptance of this reply as timely and complete to Deposit Account No. 19-0089.

Further, although no extension of time is believed to be necessary at this time, if it were to be found that an extension of time were necessary to render this reply timely and/or complete, Applicants request an extension of time under 37 CFR §1.136(a) in the necessary increment(s) of month(s) to render this reply timely and/or complete and the Commissioner is authorized to charge any necessary extension of time fee under 37 CFR §1.17 to Deposit Account No. 19-0089.

Any comments or questions concerning this application can be directed to the undersigned at the telephone or fax number given below.

Respectfully submitted,
Guillaume MATHIEU et al.

A handwritten signature in black ink, appearing to read "James L. Rowland", is written over a horizontal line.

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